

REMARKS:

Claims 1-35 are currently pending in the Application.

Claims 2-4, 7-9, 11-13, 16-18, 20-22, and 25-27 are currently canceled without *prejudice*, herewith.

Claims 1-9, 28, and 29 stand rejected under 35 U.S.C. § 101.

Claims 1-9, 28, and 29 stand rejected under 35 U.S.C. § 112, second paragraph,

Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 stand rejected under 35 § U.S.C. 103(a) over U.S. Patent No. 5,758,327 to Gardner *et al.* ("*Gardner*") in view of U.S. Patent No. 7,117,165 B1 to Adams *et al.* ("*Adams*").

Although the Applicants believe Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 are directed to patentable subject matter without amendment, the Applicants have amended Claims 1, 5, 6, 28, and 29 to more particularly point out and distinctly claim the Applicants invention. The Applicants respectfully submit that the amendments to Claims 1, 5, 6, 28, and 29 are not necessitated by any prior art and are unrelated to the patentability of the present invention. In addition, the Applicants have canceled Claims 2-4, 7-9, 11-13, 16-18, 20-22, and 25-27 without *prejudice*. By making these amendments, the Applicants make no admission concerning the merits of the Examiner's rejection, and respectfully reserve the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicants reserve the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 101:

Claims 1-9, 28, and 29 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The Applicants respectfully disagree.

Nonetheless, the Applicants have amended Claims 1, 5, 6, 28, and 29 to more particularly point out and distinctly claim the Applicants invention. The Applicants respectfully submit that Claims 1, 5, 6, 28, and 29 are directed to patentable subject matter and are clearly directed to patentable subject matter. In addition, these amendments are not considered narrowing or necessary for patentability. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 101, as set forth in the Office Action.

For at least these reasons, the Applicant respectfully submits that Claims 1-9, 28, and 29 are directed to statutory subject matter. The Applicants further respectfully submit that Claims 1-9, 28, and 29 are in condition for allowance. Therefore, the Applicants respectfully request that the rejection of Claims 1-9, 28, and 29 under 35 U.S.C. § 101 be reconsidered and that Claims 1-9, 28, and 29 be allowed.

REJECTION UNDER 35 U.S.C. § 112:

Claims 1-9, 28, and 29 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Applicants respectfully disagree.

Nonetheless, the Applicants have amended Claims 1, 5, 6, 28, and 29 to more particularly point out and distinctly claim the Applicants invention. The Applicants respectfully submit that Claims 1, 5, 6, 28, and 29 are directed to patentable subject matter and are clearly directed to patentable subject matter. In addition, these amendments are not considered narrowing or necessary for patentability. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 112, as set forth in the Office Action.

The Applicants respectfully submit that Claims 1-9, 28, and 29 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. The Applicants further respectfully submit that Claims 1-9, 28, and 29 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 1-9, 28, and 29 under 35 U.S.C. § 112 be reconsidered and that Claims 1-9, 28, and 29 be allowed.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 stand rejected under 35 U.S.C. 103(a) over *Gardner* in view of *Adams*.

Although the Applicants believe Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 are directed to patentable subject matter without amendment the Applicants have amended Claims 1-9, 28, and 29 to more particularly point out and distinctly claim the Applicants invention. In addition, the Applicants have canceled Claims 2-4, 7-9, 11-13, 16-18, 20-22, and 25-27 without *prejudice*. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicants respectfully submit that the ***amendments to independent Claims 1, 28, and 29 have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims.*** The Applicants further respectfully submit that amended independent Claims 1, 28, and 29 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Gardner* or *Adams*, either individually or in combination. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 under 35 U.S.C. § 103(a) over the proposed combination of *Gardner* and *Adams*, either individually or in combination.

The Proposed *Gardner-Adams* Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims

For example, with respect to independent Claim 1, this claim recites:

A computer-implemented system for generating a request for quote (RFQ), comprising:

an RFQ engine comprising one or more components, wherein the one or more components are organized logically into one or more tiers, the RFQ engine comprising:

a data and metrics tier operable to generate, in response to input from a user, a data and metrics model for an RFQ template using a data and metrics meta-model;

a state transition tier operable to generate, in response to input from the user, a state transition model for the RFQ template using a state transition meta-model; and

a workflow tier operable to generate, in response to input from the user, a user interface workflow for the RFQ template using a workflow meta-model;

wherein the RFQ engine further comprises an execution engine operable to execute the RFQ template comprising the data and metrics model generated by the data and metrics tier, the state transition model generated by the state transition tier, and the user interface workflow generated by the workflow tier, the RFQ template being executed to generate an RFQ.. (Emphasis Added).

Independent Claims 10, 19, and 28-31 recites similar limitations. *Gardner* and *Adams* fail to disclose each and every limitation of independent Claims 1, 10, 19, and 28-31.

The Office Action Acknowledges that *Gardner* Fails to Disclose Various Limitations Recited in Applicants Claims

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Gardner* fails to disclose various limitations recited in independent Claim 1. Specifically the Examiner acknowledges that *Gardner* fails to teach “*a workflow [tier] operable to generate, in response to input from the user, a user interface workflow for the RFQ template using a workflow meta-model*”. (21 February 2007 Office Action, Pages 5-6). However, the Examiner asserts that the cited portions of *Adams* disclose the

acknowledged shortcomings in *Gardner*. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in *Adams*.

The Applicants respectfully submit that *Adams* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a **"computer-implemented system for generating a request for quote (RFQ)"** and in particular *Adams* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding "a **workflow tier operable to generate**, in response to input from the user, **a user interface workflow** for the RFQ template using a workflow meta-model". In particular, the Examiner equates the **"workflow tier"** recited in amended independent Claim 1 with the **"wizard"** disclosed in *Adams*. (21 February 2007 Office Action, Page 6). However, **the wizard disclosed in Adams** is merely a requisition wizard for employees who need to buy something, but **does not include, involve, or even relate to the workflow tier**, as recited in amended independent Claim 1. (Column 3, Lines 9-56). In contrast, the **"workflow tier"** recited in amended independent Claim 1 **is operable to generate**, in response to input from the user, **a user interface workflow** for the RFQ template using a workflow meta-model. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Adams* and independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Adams*.

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Gardner-Adams* Combination

The Applicants respectfully submit that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Gardner* or *Adams*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been obvious to one of ordinary skill in the art, at the time of the invention was made, to incorporate the wizard of

Adams into the invention of *Gardner*". (21 February 2007 Office Action, Page 6). (Emphasis Added). The Applicants respectfully disagree.

The Applicants further respectfully submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Gardner* or *Adams*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be "*in order to guide a user through a series of questions at each step, providing navigational aids to keep track of the big picture, and presenting lists of choices whenever possible instead of asking the employee to type things in*". (21 February 2007 Office Action, Page 6). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. ***The Applicants respectfully request the Examiner to point to the portions of Gardner or Adams which contain the teaching, suggestion, or motivation to combine these references for the Examiner's stated purported advantage.*** The Applicants further respectfully submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Gardner or Adams to render obvious the Applicants claimed invention.*** The Examiner's unsupported conclusory statements that "it would have been obvious to one of ordinary skill in the art, at the time of the invention was made, to incorporate the wizard of *Adams* into the invention of *Gardner*" and "*in order to guide a user through a series of questions at each step, providing navigational aids to keep track of the big picture, and presenting lists of choices whenever possible instead of asking the employee to type things in*", ***does not***

adequately address the issue of motivation to combine. (21 February 2007 Office Action, Page 6). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Gardner or Adams***, either individually or in combination.

The Applicants Claims are Patentable over the Proposed Gardner-Adams Combination

The Applicants respectfully submit that independent Claim 1 is considered patentably distinguishable over the proposed combination of *Gardner* and *Adams*. This being the case, independent Claims 10, 19, and 28-31 are also considered patentably distinguishable over the proposed combination of *Gardner* and *Adams*, for at least the reasons discussed above in connection with independent Claim 1.

Furthermore, with respect to dependent Claims 5, 6, 14, 15, 23, and 24: Claims 5 and 6 depend from independent Claim 1; Claims 14 and 15 depend from independent Claim 10; and Claims 23 and 24 depend from independent Claim 19. As mentioned above, each of independent Claims 1, 10, 19, and 28-31 are considered patentably distinguishable over *Gardner* and *Adams*. Thus, dependent Claims 5, 6, 14, 15, 23, and 24 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants respectfully submit that Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 are not rendered obvious by the proposed combination of *Gardner* and *Adams*. The Applicants further respectfully submit that Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability,*** and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

7 May 2007

Date

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